



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/811,008

03/26/2004

Gene Kelly Norris

A01506

8986

21898 7590 12/27/2006  
ROHM AND HAAS COMPANY  
PATENT DEPARTMENT  
100 INDEPENDENCE MALL WEST  
PHILADELPHIA, PA 19106-2399

EXAMINER

LISTVOYB, GREGORY

ART UNIT

PAPER NUMBER

1711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

12/27/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,008	<b>Applicant(s)</b> NORRIS ET AL.	
	<b>Examiner</b> Gregory Listvoyb	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/2, 8/16</u> | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10 rejected under 35 U.S.C. 102(b) as being anticipated by Kublak et al (US Patent 3597378), herein Kublak.

Kublak teaches a wax, comprising a reaction product of the following components:

- A. linear dicarboxylic acid (preferably, Sebacic (C6),
- B. monocarboxylic acid (preferably, Stearic (C18))
- C. diamines (preferably, Ethylenediamine) (Method A, Column 2)

Molar ratio of B to A is within the range of 1: 1 to 6:1 and the number of acidic groups in A and B equal to number of amino groups in C.

Therefore, a ratio of total number of equivalents of carboxylic acid to diamine is equal to 1.00

In Table 1, Example 9, Kublak disclose a wax with melting point of 230-240C, which is a product of reaction of 30% Sebacic acid, 56% of Stearic acid and 14% of Ethylenediamine.

Therefore, the limitations of Claims 1-4 and 6 are met.

In the case there Sebacic and Stearic acid added in the ratio one to one , the amount moles of Diamine would be equal to 1.5. In weight percent The amount of the above components, expressed in weight percent will be 35 % of Sebacic acid, 49% Stearic acid and 16% of Ethylene Diamine.

Thus, the limitations of Claims 3 and 5 are met.

Kublak teaches that melting point range of the above waxes is 300-600F (150-315C), which matches the corresponding values in the Specification of the Application, confirming similarity of Kublak's wax compositions and ones in the Application.

### ***Claim Rejections - 35 USC § 102/103***

Claim 9 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kublak.

Kublak discloses a wax comprising saturated monocarboxylic acid, dicarboxylic acid and diamines (see discussion above).

Kublak teaches that Ethylene diamine is added to Sebacic acid (while stirring) with following addition of Stearic acid (Method A, Column 2).

Kublak fails to teach sub-surface addition of diamines. However, since the finished products of the Reference and the Application are produced from the same reactants and substantially identical, MPEP 2113 (Product-by-Process Claims) is applicable.

The Kublak's and the Applicant's waxes, which produced from the same diamines, diacid and monoacid, have Molecular Weight, controlled by Melting Point. Since the ranges of Melting Points in both cases overlap, the products are identical.

### ***Double Patenting***

Claims 1-10 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 7009030 in view of Kublak.

U.S. Patent No. 7009030 teaches a composition comprising dicarboxylic acid and diamines. However, open language ("comprising") used in Claim 1 of the Patent does not exclude a presence of monocarboxylic acid.

Kublak teaches wax, which produced by reaction of dicarboxylic acids and diamines and monocarboxylic acid, where the latter ingredient acts as a chain length

regulator. It would be obvious to a person with average skills in the art to use a monocarboxylic acid as a chain regulator to obtain a wax with predefined molecular weight, which corresponds with a melting point.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Listvoyb whose telephone number is (571) 272-6105. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory Listvoyb  
Examiner  
Art Unit 1711

\*\*\*

Application/Control Number: 10/811,008  
Art Unit: 1711

Page 6

A handwritten signature in black ink, appearing to read 'James J. Seidleck', positioned above the printed name.

James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700